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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,179	03/02/2004	Jean-Louis H. Gueret	08048.0045-00	3236

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WASHINGTON, DC 20001-4413

EXAMINER
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KARLS, SHAY LYNN

ART UNIT	PAPER NUMBER
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3723

MAIL DATE	DELIVERY MODE
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10/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/790,179

Applicant(s)

GUERET, JEAN-LOUIS H.

Examiner

Shay Karls

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) 7,10,15,19,22,42,45,50,54 and 57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,9,11-14,16-18,20,21,23-41,43,44,46-49,51-53,55,56 and 58-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 6/26/07; 3/2/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election in Group A of i, Group b of ii, Group C of i, Group D of i, Group E of i, Group F of i, of Group G of ii, and of Group H of i, in the reply filed on 8/2/07 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 7, 10, 15, 19, 22, 42, 45, 50, 54 and 57 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/2/07.

The applicant included claims 15 and 50 in the listing of claims however, claims 15 and 50 are directed toward having the bristles rows being axially offset. The applicant elected the species where the bristle rows are axially aligned (Group G). Therefore, claims 15 and 50 are being withdrawn.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-6, 8, 11-12, 14, 16-18, 20-21, 23-41, 43, 46, 48-49, 51-53, 55-56, 58-68 are rejected under 35 U.S.C. 102(b) as being anticipated by Gueret (USPN 7156105).**

With regards to claim 1 and 34, Gueret teaches an applicator for applying a cosmetic product comprising an applicator element wherein the applicator comprises a support (151) made from a plastic material (col. 3, lines 14-16). There is at least one bundle of bristles (155) associated with the support. The bundle comprises an end portion defining a first row of bristles (figure 23, bristles extending downward) extending substantially in a longitudinal direction of the support. The bundle is split into at least two sub-bundles extending away from the end portion (right and left bundles on figure 23). The sub-bundles define a second and third row of bristles extending at least outside the support. The support defines a plurality of openings (153) that the sub-bundles pass through (claim 34). While the bristles in figure 23 might be three separate bundles, it is clear that a single bristle bundle could have been used and positioned such that the bristle bundle is split among the openings 153 in the support. The support is clearly capable of supporting one single bundle or three separate bundles. Figure 12 and 26 shows that a single bristle bundle is capable of extending through the entire support.

With regards to claim 2, 35 and 37, the first row of bristles extends at least in part outside of the support (figure 23).

With regards to claim 3 and 38, the first row of bristles comprises a number of bristles that is substantially equal to the number of bristles in the second and third rows.

With regards to claim 4, 36 and 39, the support defines distinct openings (153), wherein the second and third rows of bristles comprise respective succession of tufts exiting the support via the distinct openings (figure 23).

With regards to claim 5 and 40, the first row of bristles comprises a substantially continuous sheet of bristles (the bundle is considered to a sheet since there is no limitation further explaining what a sheet is).

With regards to claim 6 and 41, the bundle of bristles is split to form the second and third rows inside the support (figure 23).

With regards to claim 8 and 43, the second and third rows of bristles extend from one side of the support relative to a separation plane containing a longitudinal axis of the support, and wherein the first row extends from an opposite side of the support relative to the separation plane (the separation plane extends through the crossing of the distinct openings in figure 23).

With regards to claim 11 and 46, the support comprises at least one row of teeth (points of triangle are considered to be teeth).

With regards to claim 12, the row of teeth extends between the second and third rows of bristles (figure 23).

With regards to claim 14, 48 and 49, the second and third rows each comprise tufts of bristles, and wherein the tufts of the second row and the tufts of the third row are disposed at substantially the same level along an axis of the support (figure 23, shows that the length of the bristles are the substantially the same).

With regards to claim 16 and 51, the support defines openings (153) situated respectively in two opposite faces (152) of the support, and wherein the sub-bundles each define at least one tuft exiting the support via the openings.

With regards to claim 17 and 52, the support defines openings (153) situated respectively in the same face (152) of the support (the length of the support has many openings in the same face, see figure 18-19; figure 23 is only a cross section of one of the openings) and wherein the sub-bundles each define at least one tuft of bristles exiting the support via the openings.

With regards to claim 18 and 53, the support has a rectilinear longitudinal axis.

With regards to claim 20 and 55, the apparent length of the bristles of at least one row varies along a longitudinal axis of the support (the length varies due to the flaring caused by opening 154 in figure 23).

With regards to claim 21 and 56, the support defines openings comprising axes perpendicular to a longitudinal axis of the support and wherein the bristles pass through the openings and extend away from the support (the longitudinal axis is a line and therefore all the faces 152 of the support can be considered to be perpendicular to the axis).

With regards to claim 23 and 58, the plastic material of the support is a rigid material, semi-rigid material or an elastomer (col. 3, lines 51-54).

With regards to claim 24 and 59, there is further a stem (11), a cap (12) and a receptacle (2). The applicator element is located at one end of the stem and the cap is located at another end of the stem (figure 1).

With regards to claim 25 and 60, the support is fitted to the stem.

With regards to claim 26 and 61, the support and the stem have a one-piece integral construction (figure 1).

With regards to claim 27 and 62, the applicator is configured to apply the product to at least one of eyelashes and eyebrows (col. 5, lines 10-12).

With regards to claim 28 and 63, the at least one bundle of bristles comprises a plurality of bundles of bristles and each is split into at least two sub-bundles (this occurs along the longitudinal length of the support).

With regards to claim 29 and 64, the support defines a plurality of openings (153) and wherein the bristles of the sub-bundles pass through the openings and extend away from the support.

With regards to claim 30 and 65, there is a cosmetic product being applied via the applicator (col. 4, lines 65-67).

With regards to claim 31 and 66, the cosmetic product is a product for the eyelashes (col. 4, lines 65-67).

With regards to claim 32 and 67, there is further a receptacle (2) to contain the cosmetic product.

With regards to claim 33 and 68, there is further a wiper (5) associated with the receptacle.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 13 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret ('105).**

Gueret teaches all the essential elements of the claimed invention as stated above however fails to teach that the major dimension of the support in a plane perpendicular to a longitudinal axis of the support is less than or equal to 5mm. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the major dimension of Gueret so that it is less than or equal to 5mm since the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device. Therefore, the claimed device was not patentably distinct from the prior art device. Further one of skill in the art would by



routine experimentation determine the optimum size of the major dimension of the support to optimize the performance of the brush. MPEP 2144.

**Claims 9 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret ('105).**

Gueret teaches all the essential elements of the claimed invention as stated above however fails to teach that the bristles are held to the support by overmolding the plastic on the bristles. The bristles of Gueret are secured by friction fit however the final end product is essentially the same as the present invention. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process used to secure the bristles to the support so that overmolding is the process used to make the product. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. MPEP 2113. Given that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shay Karls whose telephone number is 571-272-1268. The examiner can normally be reached on M-Th 7-430; alternating F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe Hail can be reached on 571-272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Shay Karls  
Examiner  
Art Unit 3723